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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,475	01/02/2002	Hiroshi Danjo	0649-0822P-SP	5594
2292	7590	01/23/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ANTHONY, JOSEPH DAVID	
			ART UNIT	PAPER NUMBER

1714

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,475

Applicant(s)

DANJO, HIROSHI

ed

Examiner

Joseph D. Anthony

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to a bleaching formulation, classified in class 252, subclass 186.33.
 - II. Claims 9-10, drawn to a method of bleaching, classified in class 8, subclass 111.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used as a polymerization initiator.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with John W. Bailey on 11/18/03 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8.

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Affirmation of this election must be made by applicant in replying to this Office action.

Claims 9-10 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 uses improper Markush claim language and is thus indefinite in regards to the metes and bounds of the claimed peroxy bleaching agent. Applicant can correct this problem by amending lines 3-5 to read as : --(a) a peroxy bleaching agent selected from the group consisting of hydrogen peroxide, an organic peroxide, and an organic peracid, the organic peroxide and the organic peracid. . . --.

Dependent claim 3 also uses improper Markush claim language which also needs to be corrected.

Claims 2-8 are being rejected here because they are dependent on a rejected base claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Collins et al. U.S. Patent Number 5,876,625 or Collins et al. U.S. Patent Number 5,853,428 or Collins et al. WO 99/58634.

All three Collins et al. references teach hydrogen peroxide containing bleaching compositions comprising metal ligand chelate salt complex bleach activators wherein the anionic part of the metal ligand chelate salt complexes read directly on applicant's claimed anionic bleaching activator (b), and wherein the cationic part of the metal ligand chelate salt complexes read directly on applicant's claimed cationic compound (c), see the abstract of each reference. Applicant's claims are deemed to be anticipated over Examples 26 and 30-30 of

5,853,428; over Examples 26-31 of 5,876,625; and over Examples 26, and 30-35 of WO 99/58634.

11. Claims 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Collins et al. U.S. Patent Number 5,876,625 or Collins et al. U.S. Patent Number 5,853,428 or Collins et al. WO 99/58634.

All said Collins et al references have been described above. Applicant's claims are deemed to be anticipated over said cited Examples of each reference. In the alternative, it is unclear from said cited examples of each reference if the metal ligand chelate salt complexes used in combination the aqueous hydrogen peroxide containing solutions actually read on applicant's claimed anionic bleaching activator (b) and cationic compound (c).

It would have been obvious to one having ordinary skill in the art to use the broad disclosure of anyone of the three references as strong motivation to actually used metal ligand chelate salt complexes that do in fact read on applicant's claimed anionic bleaching activator (b) and cationic compound (c). Applicant's specifically claimed cationic compound (c) is directly taught as the cationic counter ion for the anionic part of said metal ligand complexes, see Examples 19-22 of '625; Examples 19-22 of '428; and Examples 19-22 of WO. Furthermore, the generic formula of the oxidatively stable metal ligand chelate salt complex bleach activators, as set forth in the abstracts of each claim encompass applicant's claimed components (b) and (c).

12. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins et al. U.S. Patent Number 5,876,625 or Collins et al. U.S. Patent Number 5,853,428 or Collins et al. WO 99/58634.

All said Collins et al references have been described above, and they differ from applicant's claimed invention in the following ways: 1) there is no direct teaching (i.e. by way of an example) to where one of applicant's claimed bleaching agents is actually used in combination with the taught oxidatively stable metal ligand chelate salt complex bleach activators (see applicant's claim 2), and 2) there is no direct teaching (i.e. by way of an example) to where the concentration amount of the applicant's cationic compound (c) falls within applicant's claimed range of 0.1 to 99% by weight (see applicant's claim 7).

It would have been obvious to one having ordinary skill in the art to use the broad disclosure of anyone of the Collins et al references as strong motivation to actually use one of applicant's claimed bleaching agents since these bleaching agents are directly disclosed in the specifications of each reference as highly useful oxidants for their compositions, see column 8, lines 42-67 of '625; column 9, line 65 to column 10, line 25 of '428; and page 18, line 20 to page 19 line 8 of WO.

It would also have been obvious to one having ordinary skill in the art to use the broad concentration ranges for the oxidatively stable metal ligand chelate salt complex bleach activators as suggested by each reference as strong

motivation to use a concentration of oxidatively stable metal ligand chelate salt complex bleach activator that is such that the cationic counter ion concentration is within applicant's claimed range of 0.1 to 99% by weight, see column 8, lines 30-35 and column 10, lines 49-60 of '625; column 9, lines 51-57 and column 12, lines 5-17 of '428; and page 18, lines 11-15 of WO.

Prior-Art Cited But Not Applied

13. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention. Please note that the other Collins et al references which are cited but not applied, are deemed to be highly relevant over applicant's claims but are not being applied because they are deemed to be redundant over the Collins et al references that were actually applied over applicant's claims.

Examiner Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (703) 308-0446 until 12/04/03; after 12/04/03 my new telephone number will be (571) 272-1117. This examiner can normally be reached on Monday through Thursday from 7:35 a.m. to 6:00 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The centralized FAX machine number is (703) 872-9306. All other papers

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received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0651. The receptionist is located on the 8th floor of Crystal Plaza 3 (e.g. CP-3) and will be the welcome point for all visitors to the building.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

12/13/03